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In the Supreme Court of the United States

OCTOBER TERM, A. D. 1949.

No. 730.

E. B. KAISER COMPANY,
Petitioner,
v.
THE KIC-WIL COMPANY,
Respondent.

BRIEF OF RESPONDENT
In Opposition to Petition for Writ of Certiorari.

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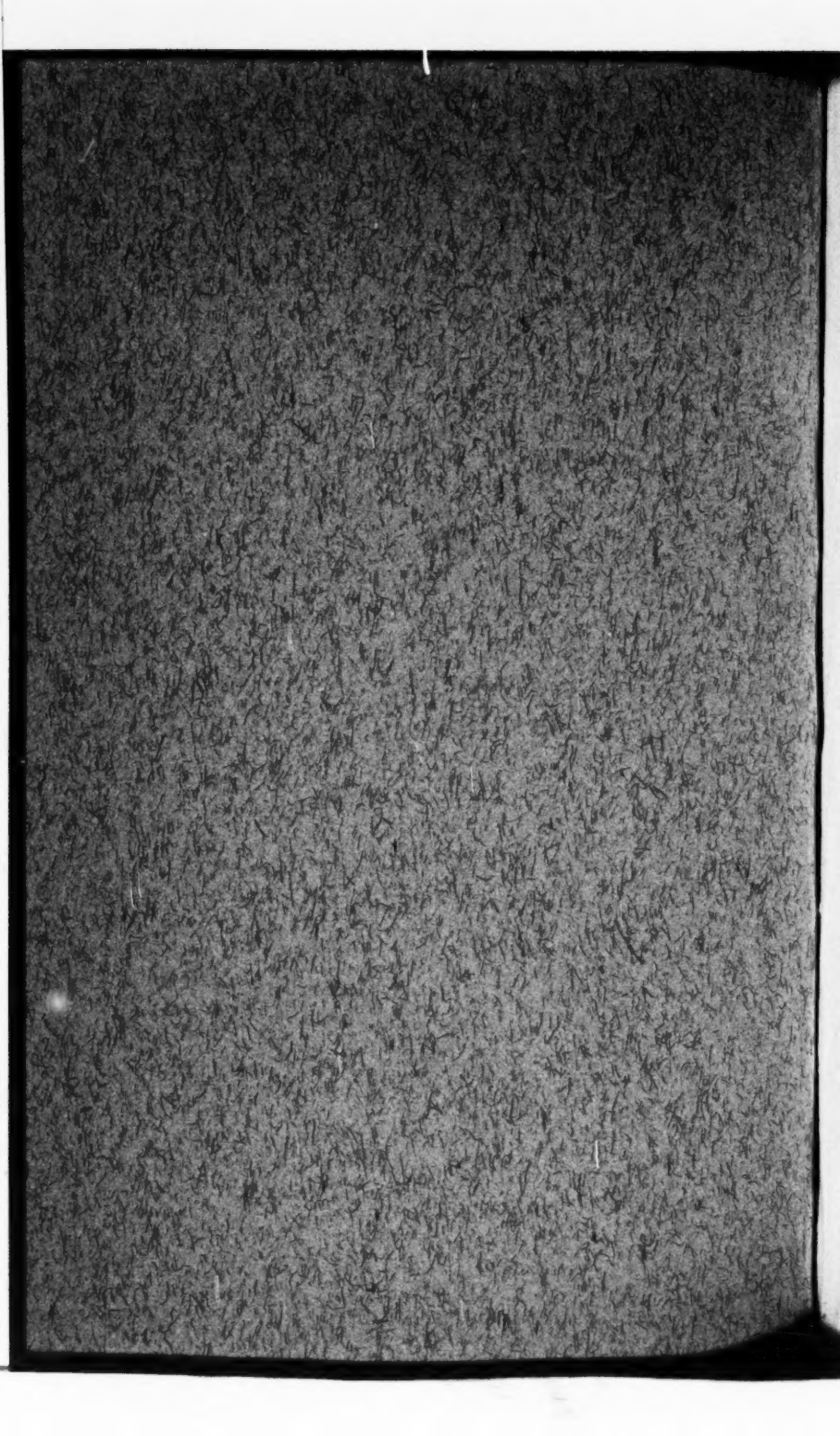

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No. 730.

E. B. KAISER COMPANY,
Petitioner,

v.

THE RIC-WIL COMPANY,
Respondent.

BRIEF OF RESPONDENT

In Opposition to Petition for Writ of Certiorari.

STATEMENT OF THE CASE.

The introductory paragraph of the Petition for Writ of Certiorari (page 1) and the first paragraph of Petitioner's "Summary and Statement of Matter Involved" (page 2) are substantially correct, but at this point in the Petition all attempt at accuracy ends.

Starting with the next paragraph the Petition (and the annexed Brief in its support) becomes a mere jumble of Petitioner's opinions which are substituted for actual facts, of distortions created by lifting fragments of the record out of context, and of totally unjustified conclusions jumped to from these unwarranted premises.

SOME UNWARRANTED PREMISES.

High amongst the substitutions of Petitioner's opinion for actual facts are the various holdings which it attributes to the District Court and to the Circuit Court of Appeals.

A comparison of the "holdings" which Petitioner attempts to put in the mouths of these two Courts with the decisions which they actually rendered shows only the

most superficial resemblance. It indicates clearly Petitioner's inability to base even a plausible sounding Petition upon the true decisions of the Courts below, and shows that its entire request for certiorari is merely a frivolity and a sham.

"THE QUESTIONS PRESENTED."

Specifically, neither Court made any holding having the meaning inferred by **any one** of the three "Questions Presented" (Petition, p. 6).

1. The Circuit Court of Appeals for the Seventh Circuit did **not** hold "that prior art patents **which disclosed the patented thing**" cannot invalidate "without clear and convincing testimony," although Petitioner so stated in the first "Question Presented." (Emphasis ours throughout, unless otherwise stated.)

2. The decision of the Circuit Court of Appeals for the Seventh Circuit did **not** deal with any attempt to "repudiate construction" of a claim (Second "Question Presented"), but on the contrary, it affirmed the finding of fact of the District Court holding that Petitioner's device comes within the actual words adopted in the Patent Office (Finding 15, Rec. p. 313).

3. The decision of the Circuit Court of Appeals for the Seventh Circuit did **not** approve "the redrafting of a claim by disclaimer" as suggested by the third "reason relied on for allowance of the Writ" (Petition, p. 6).

Nor are "The Questions Presented" at all aided or improved by the three "Specifications of Errors" (petitioner's Brief, p. 16) which appears to be an attempt to rephrase these questions, and is further discussed later.

On the other hand, much of the argument presented in the Petition and accompanying Brief is based upon matter which was not presented before the District Court and Circuit Court of Appeals at all, as will be more fully pointed out hereinafter.

PETITION FAILS TO SHOW ANY GROUND FOR CERTIORARI.

Moreover, the Petition fails to comply with Rule 38 of the Rules of the Supreme Court of the United States, *first*: in that the accompanying Brief is not direct and concise as required by Paragraph 2 of this Rule, and *second*: in that the subject matter which it attempts to present is merely the ordinary questions of validity and infringement, based on conventional grounds such as paper prior art, which are found in every infringement suit; and hence, the case is not one coming within Paragraph 5 of the Rule "where there are special and important reasons therefor."

Obviously, the subject matter does not come within subparagraph (a) of paragraph 5 of Rule 38, as there is no Federal question decided by a State Court involved.

Clearly, also, it does not come within paragraph (b) relating to conflicting decisions of two different Circuit Courts of Appeals.

And clearly, also it does not come within paragraph (c) relating to the U. S. Circuit Court of Appeals for the District of Columbia.

All that the Petition alleges is that the Court of Appeals did not give as much weight to the prior art patents and to the proceedings in the Patent Office as Petitioner desires.

SUMMARY OF THE REAL "MATTER INVOLVED."

As above indicated, Petitioner obviously bases its entire Petition upon the fact that the District Court and the Circuit Court of Appeals concurred in finding it guilty of flagrant infringement of Respondent's patents.

It is understandable that Petitioner has found its appropriation of Respondent's inventions profitable and therefore desires to continue its infringement thereof.

ARGUMENT.

Inasmuch as Petitioner has relied solely on a large number of reference patents—135 in all—and the testimony of a single alleged expert witness (which testimony turned out to be extremely unsatisfactory for Petitioner), there is little upon which Petitioner can base its case other than by argument, presenting and rearguing for a third time defenses based on the prior art, together with an alleged file wrapper estoppel or two.

That this is the sole purpose of its Petition becomes evident from the Brief which accompanied its Petition, as well as from the record which has now been presented. In the latter it is significant that Petitioner has included copies of eleven of its 135 reference patents and extracts from the file wrappers of three of the patents in suit.

It is also significant that Petitioner has devoted 13 pages (pages 11-14, 18, 24-27 and 29-32) of the 30 pages of its Brief in support of its Petition to the argument of specific prior art patents which it now claims to be anticipatory of Respondent's patents.

Obviously the Petitioner had every opportunity of presenting all this subject matter in the Court of original jurisdiction.

Some of it was so presented, but much of it was never brought before that Court for consideration, and therefore was not before the Circuit Court of Appeals, and so can not properly be brought for the first time before the Supreme Court.

Obviously, this is an attempt to foist upon the Supreme Court the job of determining the ordinary issues of anticipation and infringement and to waste the Court's time on matter not properly before it upon Writ of Certiorari, and as to which the decision of the Circuit Court of Appeals should be final.

> "Such an *ordinary patent* case, with the *usual issues of invention, breadth of claims,* and *noninfringement,* this

court *will not bring here by certiorari,* unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. We therefore find ourselves mistaken in assuming that an important issue of general patent law, under section 4916, R. S., is here involved. The result is that an order must be entered dismissing the writ of certiorari as improvidently granted, at the costs of the petitioner. Writ dismissed." *Keller et al. v. Adams-Campbell Co., Inc. et al.,* 44 S. Ct. 356 (358) (264 U. S. 314) 1924.

"There is nothing in the lower court's decision on either of the added questions to warrant review here. Whether respondents acquiesced in the infringement and are estopped depends upon the facts. Granting of the writ *would not be warranted merely to review the evidence or inferences drawn from it.* • • •

"Moreover, the decision on that point rests on *concurrent findings.* They are *not to be disturbed* unless plainly without support.

"There is evidence to support them. Nor would the writ be granted to review the questions of *anticipation and invention* that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals." *General Talking Pictures Corp. v. Western Electric Co.,* 58 S. Ct. 849 (351) (304 U. S. 175, 546) 1937.

"The issues of fact, contested in a long hearing *are not before us for review.* Petitioner assured us, in support of the petition for certiorari here, that 'there is no factual controversy before this Court' and 'we assume the findings of the District Court. Our challenge is directed only to the legal import of these unchallenged facts.'

"Much of petitioner's argument seems to depart from these assumptions and to *invite us to reach conclusions from the voluminous record* in the case, *contrary to those reached by the two courts below.* This we cannot do.

"A seasoned and wise rule of this Court makes concurrent findings of two courts below final here in the absence of very exceptional showing of error." *Com-*

stock v. Group of Institutional Investors, 68 S. Ct. 1454 (1456) (335 U. S. 211) 1948.

"This writ must be dismissed. The petition therefor stated that the cause involved a grave question of vital importance to the public, and alleged as special reason for its re-examination that the decree would deprive petitioner of property without due process of law and of freedom to contract, contrary to the federal Constitution. * * *.

"(1) The argument developed that the controverted *question was whether the evidence sufficed* to establish actual dedication of petitioner's property to public use—primarily a question of fact. That is not the ground upon which we granted the petition, and, if sufficiently developed, would not have moved us thereto." *Southern Power Co. v. North Carolina Public Service Co. et al.,* 44 Sup. Ct. 164 (165) (263 U. S. 508) 1924.

PETITIONER'S FURTHER ATTEMPTS TO MISLEAD THE COURT.

As a basis for this attempt, as above suggested, Petitioner has allowed its imagination to run rampant and has substituted its opinion for the actual facts, some examples showing the extent to which it has departed from the real facts follow:

In the second paragraph of Petitioner's Summary and Statement of Matter Involved (page 2), it is stated, "This is **not** a case in which courts below concurred in **finding significant differences** between the prior art and the patents in suit. Neither Court **recognized any differences** between the prior patent art and the patents in suit."

But what did the Circuit Court of Appeals for the Seventh Circuit say about significant differences?

Chief Judge Major stated (Record, pp. 380 and 381):

"That the disclosure *represented marked advancement* in the construction and insulation of a steam heating system can *hardly be doubted from this record.*

Here *for the first time* was a unit which could be completed indoors, affording workers protection in all kinds of weather and thus *increasing their efficiency,* and insuring a *better quality* product. It was capable of being transported complete, lowered into a trench substantially no larger than sufficient to receive it, could be coupled with other units quickly and accurately in which the joints could be tested and inspected immediately after they had been made, and the trench could at once be filled. The required *depth* of the trench *was also decreased* because of the metal covering employed, which enabled the conduit to *resist heavy loads and shock.* The designed structure *obviated* the necessity of keeping the trench open while the lower half of the shell was being laid and until the cement or concrete used in its construction had set—generally several days—and then keeping it open while the pipe was laid in the bottom portion of the shell and heating insulating material applied to it, and, further, keeping the trench open while the upper half of the shell was completed and waiting until that part of the shell had an opportunity to set.

"It thus became possible not only to dig a *smaller* trench but *immediately to follow* by laying units as fast as there was space prepared for them, to connect and test these as they were laid, and to refill the trench immediately as the connections were made. After installation, the strength of the "Unit-Type" *eliminated breakage* such as had occurred with the "Tunnel-Type" of construction, and if for any reason a section needed to be replaced the old section was as *readily removable* as it was installable so that *maintenance costs were reduced* both by cutting down on breakage and a saving in labor. There is **undisputed evidence** in the record that the "Unit-Type" structure **reduced** the amount of earth which had to be excavated **to 38% of what had formerly been required,** that it **eliminated substantially all breakage,** permitted installations **without interruption of traffic,** and **increased by four times the speed** with which conduits could be laid. And it was shown that the "Unit-Type" conduit of the patents in suit has largely taken the place of the older "Tunnel-

> Type." The former type represents some 85% of plaintiff's business and 100% of defendant's business. Plaintiff manufactured 4,500,000 feet (852 miles) of "Unit-Type" construction in about seven years."

How can the Petitioner have the temerity to come before the Supreme Court and attempt to tell it that these advantages recognized by the Seventh Circuit Court of Appeals are not "significant differences"?

Further in the same paragraph (Petition, p. 2) Petitioner says, "Neither Court analyzed or **discussed** a single prior art patent * * *."

In the Judgment of Judge Igoe of the District Court (Record, pp. 317, 318) more than **three dozen of the prior art patents are specifically referred to,** and it is pointed out that they do not anticipate the patents in suit. Can this be considered anything short of discussion?

In the paragraph in Petitioner's Summary and Statement of Matter Involved (starting on page 2 thereof and continuing over onto page 3) appears the following: "This is **not** a case where the Courts below concurred in finding that the patentee **had not shifted his position** from that upon the basis of which his patent was granted; nor is it a case in which the Courts below concurred in justifying the patentee's shift of position."

This, as is apparent from succeeding portions of the Petition and Brief, is based upon Petitioner's erroneous and unwarranted contention that Respondent had attempted to read out of patent 2,050,968 the words "flat plate" as descriptive of the spacer claimed in this patent, the Petitioner saying on the succeeding page (p. 4): "The accused structure of Petitioner is a three-legged spider and **not a 'flat plate.'** * * * The Court of Appeals in its opinion did not discuss this issue."

There are two separate and deliberate attempts to mislead the Court in the single slight quotation above; **first**; in the allegation that the accused structure is **not a flat plate.**

The contrary was proven and appears definitely in Finding 15 of the District Court as follows:

> "15. The **defendant's** spacer is a **flat piece of metal** having a notched periphery, and **is a 'plate'** in the sense in which the word 'plate' is used in patent No. 2,050,968." (Record p. 313.)

Second; not only is this finding quoted by the Circuit Court of Appeals in its Opinion (Record p. 386), but a few lines later on Chief Judge Major says:

> "Having concluded that these findings are not clearly erroneous, or to put it another way that they are substantially supported by the record, we find no occasion to *discuss further* the question of validity or infringement. That conclusion follows from the findings."

showing clearly that Petitioner's flat plate was expressly considered and discussed to the extent the Court deemed necessary.

Thus, as previously suggested, it becomes apparent that the alleged "Matter Involved" upon which Petitioner has based its "Questions Presented" is very largely a figment of its imagination, and that any inferences drawn therefrom are correspondingly inaccurate.

PETITION BASED ON MATTER NOT PREVIOUSLY PLEADED.

Another way in which the Petitioner has attempted to mislead the Supreme Court and to cast aspersions on the Circuit Court of Appeals and District Court, is by accusing these two Courts of having disregarded prior art patents which Petitioner **now** urges as anticipatory of certain of the patents in suit, but which **were not produced for this purpose.**

For example, starting on page 11 of Petitioner's Brief and continuing to page 14 thereof, again being resumed on page 18 of the Brief, much ado is made over the patent to

Ashcroft 235,846, Petitioner implying that the District Court and Circuit Court of Appeals were relict in not holding this to be an anticipation of Gottwald patent 1,991,455. Petitioner has craftily avoided the use of the word "anticipation" but the implication is unavoidable, as in the above mentioned pages it says:

> "Thus Ashcroft showed *each of the elements* of claim 11 of the Gottwald patent * * *.
>
> "Ashcroft also *disclosed the idea* of prefabricating the insulated pipe in section * * * (page 13).
>
> "Thus Ashcroft disclosed an insulated pipe *fully meeting* what Gottwald claimed as his in the Patent Office * * * (page 14).
>
> "The Ashcroft patent, which was published 50 years before Gottwald applied for his patent, *showed everything* claimed, responding literally and in substance. (See pp. 11 to 14 herein)." (page 18.)

But what was Ashcroft cited for?

This is shown clearly by the Bill of Particulars (starting Record p. 29) and the Amendment to the Bill of Particulars (Record p. 45), the number of this patent **appearing only** in the Bill of Particulars on pages 29 and 30 and showing that it was cited "as to the same aforesaid patent (1,991,455) the following patents are cited **as illustrative of the prior art**" and in the second instance, "as to the aforesaid patent (2,050,968) the following patents are cited **as illustrative of the prior art.**" In each instance the group of patents said to be merely illustrative of the prior art is preceded by a group stated to be "cited as anticipation."

In the 35 pages of testimony of Petitioner's witness Kellogg in regard to Gottwald patent 1,991,455 (appearing on Record pp. 172-179, 184-210), this witness discussed nine prior art patents but never made a single mention of the Ashcroft patent.

It was **not** urged by Petitioner as **anticipating any patent!**

Certainly, when this patent was presented to the District Judge it was produced solely as illustrating the prior art, and was not considered to be anticipatory in any way.

Now should the Court be subjected to criticism for not having discussed it from the standpoint of anticipation?

And certainly the Circuit Court of Appeals, not having before it the question of whether the patent anticipated, likewise should not now be criticized for not going into this matter in detail (or at all).

> "On oral argument and submission of the cause it appears that although petitioner by its amended answer alleged generally that respondents 'do not come into * * * court with clean hands,' the *answer made no mention* of the restrictions contained in the license agreement. *The District Court made no findings* of fact or law with respect to them. On appeal to the Circuit Court of Appeals *petitioner assigned no error* with reference to them and the Circuit Court of Appeals *did not consider them,* saying: 'We affirm the judgments of the District Court, considering here only the appellant's claim of error.'
>
> "Thus the *only question* for which we granted certiorari *is one not properly raised, litigated or passed upon below.* * * * The grounds asserted for the allowance of certiorari are inadequately supported by the record, and the writ is therefore dismissed." *McCullough v. Kammerer Corp. et al.,* 65 S. Ct. 297. (323 U. S. 327.) 1945.

Petitioner (on page 18 of its Brief) also refers to the patent to Bartlett 417,768, and likewise implies that this should have been held an anticipation of Gottwald patent 1,991,455.

The Bill of Particulars and its Amendment show that this patent **was not cited** against the Gottwald patent, **even as illustrative** of the prior art, but that its number is mentioned only on page 30 of the Record, where it was mentioned among those alleged to be **illustrative of the prior art** applicable to a totally **different patent, No. 2,050,968.**

In the above mentioned 35 pages of the record relating to testimony of the witness Kellogg, absolutely no reference is made to the Bartlett patent.

Again, Petitioner states in its Brief (p. 24),

> "In finding this patent (McLeish patent Re. 22,988) valid, neither Court analyzed the Steffens Patent No. 1,227,087 (R. 432) believing such analysis unnecessary and 'futile' without testimony."

Referring again to the Bill of Particulars, the Steffens patent number **appears only** on Record page 30, among the group of patents cited against **Gottwald and McLeish patent No. 2,050,968, not** against the **McLeish** patent **at all**, and even there was alleged to be illustrative of the prior art only. It was **never** cited against **either the reissue** patent **or the original** on which the reissue was based.

Illustrations of Petitioner's spacing plate and the "spider" of Elkin patent No. 1,041,256 appear on page 29 of Petitioner's Brief, together with considerable argument as to the applicability of this Elkin patent to Gottwald and McLeish patent 2,050,968.

Elkin was cited in the Bill of Particulars in only one spot on page 29, among the group of patents said to be cited as **illustrative of the prior art** in regard to **Gottwald patent 1,991,455**, and thus was **not cited** for **any purpose** in **conjunction with the patent** to which Petitioner now attempts to apply the same.

In addition to **not** having been **submitted to the District Court** for the purposes now argued, **not one of these four prior art patents was mentioned** in Petitioner's "Statement of points upon which Defendant-Appellant intends to rely on Appeal" (pp. 323-326).

We submit that it is not only unreasonable to expect the District Court and Circuit Court of Appeals to have discussed matters which were not properly brought before them, but that the attempt to castigate these Courts for their alleged failure in this regard is unfair to them in the

extreme, and is a patent attempt to misrepresent them to the Supreme Court.

LIKE ITS "QUESTIONS," PETITIONER'S "SPECIFICATION OF ERRORS" MISREPRESENTS FACTS.

The Petitioner's three "questions" are, in different verbiage, included as its Specification of Errors (Brief, p. 16), and in each instance it will be apparent that Petitioner has unconscionably distorted the statements of Chief Judge Major in making its Specification.

Specification 1. "The Court of Appeals erred in holding a patent **cannot be invalidated by self proving prior art** itself, unsupported by testimony." **No such statement appears** in the Court's Opinion (Record pp. 377-388), but the decision **does** say (Record p. 383): "The defendant's reliance upon the prior art to invalidate the claims in suit we think placed upon it the **burden of overcoming the presumption which accompanied their allowance.**"

This, it will be seen, is quite a different matter from the alleged error specified.

While neither Court made any general finding that oral testimony was required or could have helped the prior art, had they done so, they would have been within their prerogative. As indicated by the Circuit Court of Appeals, "If 135 such patents are required to show the state of the prior art, it must have been in an **uncertain and highly confused state.**" (Record p. 382.) That the need for testimony in such case is to be determined by the trial judge is well illustrated in one of the decisions cited by the Petitioner:

> "Now the question whether the judge needs the assistance of experts to understand the specifications *is for him to decide.* Doubtless he ought to be chary of assuming too readily that he does understand what he may not; but, if he is too confident, his mistake eventually transpires. *The important point is that it*

is he who must determine when he needs the help of experts and when he does not, and that decision, except in the clearest case, we should not be disposed to disturb." *Kohn v. Eimer et al.*, 265 F. 900 (902) (C. C. A. 2, 1920).

It will be noted that where Petitioner cites this decision (Brief, pp. 20, 21), it very specifically fails to quote any of its language, but applies only to Petitioner's own interpretation to the citation.

In this connection, the Circuit Court of Appeals continued in discussing the unsatisfactory character of the testimony which was submitted on Petitioner's behalf, and including Petitioner's references to paragraphs 8 and 9 of the District Court's Judgment, as immediately following the above quotation from Chief Judge Major's Opinion we find:

> "We doubt, however, the soundness of the statement in paragraph 9 that defendant's expert witness Kellogg was not qualified to testify either as to the legal effect or the engineering aspects of patents because he was not a member of the bar or a registered professional engineer. We think that such handicap *would go to the weight or credit* to be attached to his testimony rather than his qualification. **It is difficult to discern,** however, **how defendant was harmed** by the statement complained of, because *the fact is that this witness was* not disqualified to testify but *was permitted to do so in detail* concerning the claims in suit, as well as the prior art patents, and that *the court considered and weighed such testimony.* As a result the court found, 'The testimony of the witness Kellogg is not consistent within itself, and is contradictory to an established fact,' that 'The testimony of the witness Kellogg is not corroborated in any respect,' and that 'The testimony of the witness Kellogg is *so lacking in credibility as to be of substantially no weight.*'
>
> "*We have read all the testimony in the record,* including that of the witness Kellogg and *we thoroughly agree with the manner in which the court characterized his testimony.* He was permitted to take the claims in

suit one by one, compare them with prior art patents many of which had long since expired, and to state that they were a direct anticipation of the claim concerning which he was testifying. He was an avid witness and his testimony reads as though it was a biased argument rather than a statement of facts. He was much too good an expert in that he extolled the virtues of the prior art, much if not all of which had never been put to use, and deprecated the patents in suit which had been put to extensive use, to such an extreme extent that his *testimony carries no conviction.*" (Record pp. 383, 384.)

And what did the Courts do in regard to the voluminous prior art (135 patents)?

(1) Judgment (Record pp. 317, 318):

"4. That Letters Patent No. 1,991,455 marked a distinct advance in the construction of conduit systems by providing units, each consisting of an inner pipe, a covering load sustaining shell and heat insulating material, which construction overcame difficulties which had existed in prior structures for many years and has gone into wide use and largely displaced such prior structures; that this patent is not anticipated by the references cited against it, particularly, *Reimann,* 903,316; *Durant,* 1,709,844; *O'Hara,* 129,968; *Holden,* 732,209; *Loughman,* 809,963; *Widiger,* 1,459,126; *Trucano,* 1,140,633; *Farley,* 701,999; *Powell,* 1,797,443; *Lamson,* 1,122,130; *Lawrence,* 1,853,736; that this patent is good and valid at law, is of a pioneer character and is entitled to a liberal interpretation, and that defendant has infringed each of claims 11, 14, 15, 16 and 17 thereof.

"5. That Letters Patent No. 2,050,968 disclosing a spacer axially movable in a conduit shell and holding a pipe therein against motion toward the top or sides of the shell discloses invention, is not anticipated by the patents cited by defendant there against, particularly, *Babcock,* 1,368,013; *Lamson,* 1,122,130; *Elkin,* 1,041,256; *Giachetti,* 1,995,473, *Bartlett,* 417,768; *Hurst,* 462,047; *Aldrich,* 289,744; *Newton,* 241,404; *Emery,* 253,917; *Harvey,* 534,473; *Trucano,* 1,140,633;

Sherwood, 951,342; *Timby,* 379,744; *Aylsworth et al.,* 869,768; that patent 2,050,968 is good and valid at law, and that the defendant has infringed claim 2 thereof.

"6. That Letters Patent 2,378,214 is the first disclosure of an integral expansion device comprising a flat U-shaped bend of conduit pipe enclosed in a T-shaped casing and having heat insulating material between the pipe and casing; that this patent discloses invention, is not anticipated by the patents cited against it, particularly, *Holly,* 9,821; *Osborne,* 236,247; *Shepler,* 394,620; *Davis,* 231,479; *Schmidt,* 700,378; *Brown,* 1,495,066; *Latimer,* 1,466,054; *Kaeferle,* 330,221; *Feigen,* 1,440,978; *Ballantyne,* 1,703,605; *Reimann,* 803,316; *Farley,* 701,999; and is good and valid at law; and that the defendant has infringed each of claims 1, 5 and 6 thereof.

"7. That Reissue Patent No. Re. 22,988 discloses a new and useful invention in an anchor passing through a conduit shell to transmit forces from a pipe within the shell to the ground; that the patent is not anticipated by the patents cited against it by the defendant, particularly, *Babcock,* 1,368,013; *Cumpfer,* 1,481,255; *Dennis,* 2,209,325; *Rateau,* 751,998; that this patent is good and valid at law; and that the defendant's anchors, both round and square, infringe claim 1 thereof."

Surely this shows consideration of the patents by the District Court!

(2) Opinion by Chief Judge Major:

"*It was shown* that for many years central heating systems had been used but that their use was much restricted * * *" (Record p. 379.)

"Third, *it is shown* that the problem which confronted the central heating industry *was first solved* by the disclosures of the patent in suit *or,* at any rate, *its progress was immeasurably advanced* over anything which had been before relied upon. It has been held that prior art patents under these circumstances *do not anticipate.* * * * Fourth, we have already made reference to the excessive number of prior art patents offered by the defendant. *If 135 such patents are re-*

quired to show the state of the prior art, *it must have been in a highly uncertain and confused state.* And it has been held that the excessive number of such references *is in itself persuasive* of the *futility of prior attempts* to solve the problem. * * * (Record pp. 381, 382.)

"The defendant's reliance upon the prior art to invalidate the claims in suit we think placed upon it the *burden of overcoming the presumption* which accompanied their allowance. * * * (Record p. 383.)

"A study of the record is convincing that the trial judge was not only keenly alert to the issues for trial and decision but that *he gave the defendant every opportunity to show that the claims in suit were invalid.* In fact, he allowed defendant's so-called expert witness *almost unlimited latitude* in expressing his opinion upon various issues which were before the court for decision." (Record p. 385.)

Petitioner accuses the Court of failing to do various things merely because the Court has not specifically stated that it had done them, and in the entire absence of any authority for assuming that the Court had not done what is required of it.

For example, Petitioner's Brief (p. 33):

"The Courts below, *in declining to read* and in characterizing as mere 'argument' the reading by counsel (R. 384), seriously erred."

The page of the record referred to in this connection (Record p. 384) **does not say** that the Court **had declined to read**, but **does** say:

"We have carefully *considered* this argument, especially as it pertains to the prior art patents. * * *"

If this be not a statement that the Court **had** read the patents, it certainly is far from a statement that it **had not** read them.

As in *U. S. v. Chemical Foundation, Inc.*, 47 S. Ct. 1 (6) (272 U. S. 1), 1926:

"The presumption of regularity supports the official acts of public officers and, *in the absence of clear*

evidence to the contrary, courts presume that they have properly discharged their official duties."

Specification 2. "The Court of Appeals erred in construing patent claims without reference to the construction placed upon the claims by the applicant and the Patent Office when the patent was allowed" (Brief, p. 16).

Can Petitioner claim that its spacer is not a flat plate and that it consequently does not infringe a claim for a spacer comprising a flat plate? If anything, this is merely contradicting both the District Court and the Circuit Court of Appeals, because it is an absolute denial of Finding 15, above mentioned, that "defendant's spacer **is a flat piece of metal** having a notched periphery, **and is a 'plate'** in the sense in which the word 'plate' is used in patent No. 2,050,968" (Record, p. 386).

In other words, this specification is merely an attempt to ask the Supreme Court to hold that a flat piece of metal, which both Courts have held to be a plate, is not a plate.

Certainly it is no basis for the alleged error, as there has been **no change in construction** of the word "plate."

Specification 3. "The Court of Appeals erred in approving the redrafting of a claim by disclaimer and in not requiring that the subject matter disclaimed be patentably distinct from subject matter retained" (Brief, p. 16).

Petitioner has never before urged the differentiation it seems to be trying to make in this paragraph. Although this specification is somewhat confused and ambiguous, as it apparently is intended to correspond to "Question 3" appearing on page 6 of the Petition, it seems to be an attack upon the disclaimer statute based upon some feeling that restriction of a claim should be made only by "risking surrender and reissue" or upon Petitioner's attempt to confuse claim 11 with claim 12 of this patent (Petitioner's Brief, pp. 33-37).

As to the latter, it is probably sufficient to point out that claim 12 is so different from claim 11 that it was not even in issue, and that neither party and neither Court has ever suggested that it could be infringed by Petitioner's structure, while claim 11 not only was held to be infringed by both Courts but was, at least for a limited time, admitted to be infringed by Petitioner's own witness.

No question of the disclaimer was pleaded in the District Court or **properly presented in either Court below**, as clearly indicated by the Answer (Record pp. 7 to 13) and the Amendment thereto (Record pp. 22-24), in neither of which the word "disclaimer" or anything of like import appears.

As to the theory that "a patent owner filing a statutory disclaimer" is "thereby admitting invalidity of the claim as issued" (Record p. 6) which underlies Question 3 and Specification 3, this theory is, of course, just another of petitioner's substitutions of its opinion for the actual facts, as it is well established that a disclaimer has absolutely no such effect.

> "Much of the defendant's argument depends upon an *illegitimate inference from the disclaimer*; that is, that it *conclusively concedes* all the disclosure to have been in prior art except the regulation of the bath after it was formed." *United Chromium, Inc. v. International Silver Co.*, 60 F. (2d) 913 (C. C. A. 2, 1932).
>
> "His disclaimer *does not have the effect of conceding* that what was disclaimed is, in fact, in the prior art. A patentee need not, at his peril, claim all that he might." (*Sales Affiliates, Inc. v. Hutzler Bros Co., Same v. Carter Products, Inc.*, 71 F. Supp. 287 (300) (D. C., D. Md., 1947).
>
> "We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully

met and defeated, a disclaimer will not affect the real value of his patent, and to make it will save trouble and expense and do no harm. *We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect* of the other matter; and it has been so held." *Permutit Co. v. Wadham et al.*, 13 F. (2d) 454 (457) (C. C. A. 6, 1926).

IN CONCLUSION.

From the above it is apparent that the Petition presents three questions, none of which is based on the decision of the Circuit Court of Appeals for the Seventh Circuit.

The questions amount merely to the usual issues of validity and infringement, and do not present special or important reasons such as are necessary to warrant the issue of Certiorari.

Petitioner shows clearly that it seeks to re-litigate the facts on which there were concurrent findings against it in both Courts below, and has failed to show any exceptional error, and in fact has shown no error.

The Petition attempts to raise questions which were not properly raised, litigated or passed upon in the Courts below.

For these reasons it is respectfully submitted that there is no reason whatsoever for the issue of the Writ of Certiorari and that the Petition should be dismissed forthwith.

Respectfully submitted,

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